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09/440,529

11/15/1999

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2683/76979

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04/10/2002

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EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 04/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/440,529

Applicant(s)

PITRODA ET AL.

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

Serial Number: 09/440,529

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Applicant: Pitroda et al.

Filing date: 11/15/99

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every
5 feature of the invention specified in the claims. Therefore, the "entire housing" which is "reader
insertable" must be shown or the feature(s) canceled from the claim(s). No new matter should be
entered. Applicant has not shown any embodiment in the drawings in which the entire housing
may be placed in the reader. Applicant argues that figures 1, 2, 3, and 8 show this feature. The
Examiner respectfully disagrees. Figure 1 clearly shows a reader wherein parts of the card housing
10 protrude. The entire card housing cannot be placed in the reader. Figures 2, 3, and 8 fail to show
a reader.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
15 improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

20 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).

25 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-
type double patenting as being unpatentable over claims 1-24 of copending Application No.
09/587,998. Although the conflicting claims are not identical, they are not patentably distinct

from each other because the amendments expressly recite features which would have been understood from the original claims, when the latter are read in light of the specification.

Assuming, for the sake of argument, that the claims would not have been read as incorporating the newly recited limitations, Examiner alternatively finds that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to adapt the receive circuit "to receive information from an electronic transaction device" because the receive circuit is certainly there to receive something, and it is clear from some of the claims that "something" is card information, and therefore it must receive it from a device, and since the device holds information relating to electronic transactions, it is therefore an electronic transaction device. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to adapt the POS interface recited in claim 1 of 09/587,998 to transit the card information received from the receive circuit (and, in turn, from the electronic transaction device), because that is the purpose of the recited "adapter for use with point of sale card readers" as understood from the claim as a whole.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102/103

The basis for the rejections under this section were recited in previous Office actions.

Claims 1-12, and 18-22 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or alternatively under 35 U.S.C. § 103 as being unpatentable over U.S. #5,834,756 to Gutman et al. (Gutman hereinafter), either alone or in view of the prior art effectively admitted. Gutman discloses an adapter 405 for use with point of sale card readers, the adapter comprising:

a) a housing, including at least a reader-insertable portion 400 capable of being inserted in the card reader;

b) a receive circuit 422 in the housing, the receive circuit adapted to receive information from an electronic transaction device (see abstract);

c) a processor 416 in the housing connected to the receive circuit; and

d) a point of sale interface (408) in the reader insertable portion of the housing connected to the processor, the point of sale interface adapted to transmit information received from the electronic device (e.g., reconfigured card data such as a subscription to a new financial service).

5 Gutman teaches the remote configuration of the card via the receiver 422, processor 416, and through the POS interface 408. As is clear from the passages spanning column 9, line 37 to column 10, line 38, the data received from the remote device can be the data that would ordinarily appear on the magnetic stripe of a card. See especially column 10, lines 18-28. In the applicant's specification, it is also clear that an "electronic transaction device" is an electronic device used to
10 input data remotely into the receive circuit, and as mediated by the processor, output that data onto a magnetic stripe emulator. From this, the Examiner finds that the remote device mentioned by Gutman is the same as the "electronic transaction device" claimed by Applicant.

In the event that Applicant or a third party does not agree that these are the "same", Examiner alternatively finds that Applicant has effectively admitted the "electronic transaction
15 device" such as a wireless phone or PDA as prior art in the "Background" section. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use an "electronic transaction device" such as a cell phone or PDA to input data into the Gutman device because cell phones can transmit RF data to the type of interface described by Gutman, as can a typical PDA with an IR port (mentioned by Gutman as an alternative interface), and because
20 Gutman suggests the use of a wireless remote configurer only generically, to include numerous known alternatives.

Re claims 2-3, and 19, Gutman, like Applicant, has alternatives where the housing is larger than a standard credit card, and alternatives where the circuitry can be built into a card body. See e.g. column 10, lines 39-44.

25 Re claims 4-6, 18, see figures.

Re claims 7-8 20, see figure 7.

Re claims 9, 21, see column 9, lines 54-59.

Re claims 10, 22, see column 9, lines 63-67.

Re claims 11, 18 see column 9, lines 51-53.

Claims 12-17, and 23-39 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. #5,834,756 to Gutman et al.

5 Re claimd 12, 15, and 32 Official Notice is taken that data buffers are old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide data buffers connected to the processor because the processor may be busy doing other tasks at the instant the data arrives, or is due to be output. This is a fundamental part of most computer systems.

10 Re claim 13, 16, 23, and 34 Official Notice is taken that time out circuits are old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a time out circuit to the Gutman invention, because this would save battery power, as is well known in the art. This would function such that the data buffer would be purged (turned off, and the data erased) after a predetermined period of time.

15 Re claim 14, 17, 24, 33, 35, and 39, data is typically purged from a buffer after one data operation.

Re claims 25-39, Gutman teaches a reader that can be used to emulate a plurality of different cards. The claims recite obvious steps in view of the disclosure of the device. The recited method steps are clearly suggested by column 10, lines 45 et seq.

20 Re claim 36, see column 9, lines 54-59.

25 Claims 37-38 are rejected under 35 U.S.C. § 103 as being unpatentable over Gutman in view of U.S. Patent #5,590,038 to Pitroda (" '038 " hereinafter). Gutman teaches an adapter combination as described above, but does not teach that the adapter may send a receipt to the electronic transaction device. '038 teaches an electronic transaction device in which an electronic transaction device, e.g. a smart card, can interface with the adapter. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the adapter taught by Gutman with the interface to an existing Universal Transaction Card taught by '038 because the adapter taught by Gutman emulates smart cards, which typically provide receipts

to the smart card device. A receipt is a species of "confirmation" as claimed in claim 37.

Response to Arguments

While Examiner does not necessarily agree with Applicant's arguments, upon reviewing
5 alternative prior art, Examiner concluded that Gutman probably serves as a better basis for
rejection than any of the other prior art. Examiner regrets any delay caused by this switch. This
reference was located previously during the search of the prior art, tagged as important, and
saved. Examiner is unable to explain why this reference was not cited previously, other than an
inadvertent oversight or information overload. Examiner had tagged Gutman among 42 other
10 references as "important". In the interests of saving forests and minimizing expenses for printing and
storage, Examiner cites only the ones considered most relevant. Examiner does not wish to
prolong prosecution, any more than Applicant.

Applicant's arguments with respect to claims 1-39 have been considered but are moot in
view of the new ground(s) of rejection.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The
Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is
20 available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner,
Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning
PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or
(703) 308-4357.

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MARK TREMBLAY
PRIMARY EXAMINER

April 8, 2002